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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/554,315	11/03/95	MAHN	DAE-41-111

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D3M1/0604

DIXON, EXAMINER

ART UNIT PAPER NUMBER

1247
DATE MAILED: 06/04/96

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

ART UNIT

PAPER NUMBER

DATE MAILED:

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

This application has been examined Responsive to communication filed on _____ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. Notice of References Cited by Examiner, PTO-892.
2. Notice of Draftsman's Patent Drawing Review, PTO-948.
3. Notice of Art Cited by Applicant, PTO-1449.
4. Notice of Informal Patent Application, PTO-152.
5. Information on How to Effect Drawing Changes, PTO-1474.
6. _____

Part II SUMMARY OF ACTION

1. Claims 6 - 10 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. Claims 1-5 have been cancelled.

3. Claims _____ are allowed.

4. Claims 6 - 10 are rejected.

5. Claims _____ are objected to.

6. Claims _____ are subject to restriction or election requirement.

7. This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. Formal drawings are required in response to this Office action.

9. The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are acceptable; not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).

10. The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been approved by the examiner; disapproved by the examiner (see explanation).

11. The proposed drawing correction, filed _____, has been approved; disapproved (see explanation).

12. Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has been received not been received been filed in parent application, serial no. _____; filed on _____.

13. Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. Other

EXAMINER'S ACTION

15.

The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Group Art Unit 1317.

16.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

17.

Claims 6-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Powers et al (4685984) in view of Mahn, Jr. (5411783). The cited primary reference teaches the basic claimed invention including a heat activated applique comprising a continuous indicia-bearing layer bonded to a first support layer with pressure sensitive adhesive, an upper heat activated adhesive layer bonded to a second surface of the indicia-bearing layer (col 2, lines 22-50; col 4, lines 19-31; col 5, lines 1-14). The primary reference fails to teach the die cut lines

through the layers. The secondary reference teaches that it is known in the art to die-cut layers of laminated articles as taught by the primary reference (col 3, lines 48-52). It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teachings of the reference to Mahn Jr. with the primary reference, in the absence of unexpected results, and provide die-cutting marks on the Powers et al patent to separate the images and produce individual articles. Concerning claims 7 and 8, the primary reference teaches similar material in col 5, lines 7-9. Concerning claim 9, the primary reference teaches similar material in col 6, lines 50-54.

18.

Claim 10 is rejected under 35 U.S.C. § 103 as being unpatentable over Mahn, Jr. (54117783). The cited reference teaches the basic claimed invention including bonding a heat activated laminate (col 1, 59-65) and die-cutting the laminate (col 3, lines 45-53). The aspect of bonding a specific type of layer together, as opposed to another layer, are mere obvious matters of article design choices and are of no patentable consequences to the instant question for patentability which must be manipulatively distinguished.

19.

Serial Number: 08/554315
Art Unit: 1317

-4-

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Mahn(4390387), Croner, DeVries et al, Mahn(4269885), Mahn, Sr. et al(4971644), Mahn, Sr.(4786349), Naritomi et al and Mahn, Sr. et al(4610904) are cited of interest for their teachings as set forth and additionally to show the state of the art.

20.

Crystal Mall 1 Fax Center

A facsimile center has been established in Crystal Mall 1 . The hours of operations are Monday through Friday, 8:45 AM to 4:45 PM. This new location should be used in all instances when faxing any correspondence to Group 1300. The Patent Examining Fax Center new telecopier number is (703) 308-0039. Use of the new Crystal Mall 1 center will facilitate rapid delivery of materials to the group. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989).

21.

Any inquiry concerning this communication should be directed to Merrick Dixon at telephone number (703) 308-0013.



Merrick Dixon

Group 1300